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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SIRMONS, KEVIN C	
ART UNIT	**PAPER NUMBER**
3763	

DATE MAILED: 12/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/601,545	COPPI ET AL.	
	Examiner	Art Unit	
	Kevin C. Sirmons	3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,13-16 and 18-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,13-16,18-21,23,24,26 and 27* is/are rejected.

7)☒ Claim(s) *22,25 and 28* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Objections (2ND Time)

Claim 27 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In an apparatus claim, very little patentable weight is given to a product by process claim. As long as the end structure is the same then the prior art meets the requirements of the claim. See MPEP 2112.02

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-16, 20, 21, 23, 24, 26 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "the longitudinal end thereof." There is insufficient antecedent basis for this limitation in the claim.

As to claim 13, it is unclear what applicant regards as the longitudinal end thereof. What is the reference numeral?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Melinyshyn et al U.S. Pat. No. 4,840,690.

Melinyshyn discloses a long and flexible, hollow, tubular body (11) having an insertion end and connection end (figs. 1, 2 and 4) intended to remain outside the body, and at the insertion end, at leas two element (16, 18) which are expandable/contractible by means of external operation and which are located on said tubular body at axially spaced location along the longitudinally extending tubular body at a fixed distance from each other such as to be able to operate one upstream and the other downstream of a given section of a vessel (figs. 1, 2 and 4), said expandable/contractible elements being adapted and/or being able to be adapted, with regard to the diameter in the expanded condition, to the diameter of the vessels (16, 18 are fully capable of performing the function as set forth above); and discharge ducts which are provided inside the thickness of the catheter wall (1b, 1d), wherein the length of the section between the two inflatable/deflatable elements is generally of the order of a few centimeters to about 10 cm, substantially equivalent to the stenosis of the arterial vessels or the length necessary for occluding a vascular trunk and an arterial bifurcation branch thereof,

blocking the blood flow in the second branch (it is the examiner's position that the device of Melinyshyn is fully capable of being designed so that the length is substantially equivalent to the stenosis of arterial vessels or the length necessary for occluding a vascular trunk).

However, if applicant was to take the position that the dimensions of Melinyshyn's device can not be varied or that Melinyshyn does not disclose the spacing between the two inflatable/deflatable elements may have a length on the order of between a few centimeters and about 10 centimeters. Then, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to change the dimensions of the catheter because Applicant has not disclosed that the dimensions provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the dimensions of Melinyshyn because applicant clearly stated on page 9 of his specification that "for particular applications, the two elements may be provided at distances different form those indicated above."

Therefore, it would have been an obvious matter of design choice to modify Melinyshyn to obtain the invention as specified in claim 1 because applicant dimensions lack criticality.

Claims 13, 21, 24 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by W.B. Keeling U.S. Pat. No. 2,642,874.

Keeling discloses a catheter comprising: (fig. 1); Note: The examiner has defined an opening at the longitudinal end thereof as the longitudinal end of the lumen. Furthermore, the balloons are fully capable of expanding to different diameters. As to claim 21, the device of Keeling is fully capable of performing the function, since they are structurally equivalent. As to claims 24 and 27, (fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keeling U.S. Pat. No. 2,642,874.

Keeling discloses the device substantially as claimed except that it is not clear if he discloses the length between the balloons and the diameters of the balloons. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to change the dimensions of the catheter because Applicant has not disclosed that the dimensions provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the dimensions of Keeling because applicant clearly stated on page 9 of his specification

that "for particular applications, the two elements may be provided at distances different form those indicated above."

Therefore, it would have been an obvious matter of design choice to modify Keeling to obtain the invention as specified in claims 18 and 19 because applicant dimensions lack criticality.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Keeling in view of Gants U.S. Pat. No. 2,936,760.

Keeling discloses the catheter substantially as claimed except for the end-piece is provided with tubular connections elements connected to the individual ducts. Gants discloses tubular connections elements (20, 22) connected to the individual ducts. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Keeling with the connectors as taught by Gants for connecting other medical devices.

Response to Amendment

Drawings

Applicant has amended the drawings to overcome the objection. Therefore, the objection has been withdrawn.

Claim Rejections - 35 USC § 112

Applicant has amended claims 1, 16 and 19 to overcome the rejections.

Therefore, the rejections have been withdrawn.

Response to Arguments

Applicant's arguments with respect to claims 1, 13-16 and 18-28 have been considered but are moot in view of the new ground(s) of rejection.

Claim 22 was clearly rejected by W. Bell.

Claim 23 is now rejected based on applicant's amendment and claim 24 is now rejected based on applicant's amendment. Therefore, applicant's arguments for allowance are moot in view of amendment to the claims.

Allowable Subject Matter

Claims 14-16, 23 and 26 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 22, 25 and 28 are allowable over the prior art of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin C. Sirmons whose telephone number is 571-272-4965. The examiner can normally be reached on Monday-Friday 6:30-4:00 ALT FRI.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin C. Sirmons

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Art Unit 3763